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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,218	10/16/2001	Yoko Tanaka	P 284004	3671
909	7590	03/24/2005	4CG32697-USA-AT	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			EXAMINER REID, CHERYL M	
			ART UNIT 2142	PAPER NUMBER
DATE MAILED: 03/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,218

Applicant(s)

TANAKA, YOKO

Examiner

Cheryl M. Reid

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 5 is objected to because of the following informalities: Claim 5 recites, ".....informing the terminal device to execute the download of an application required for receiving the service when the holder is judged to have no right to receive the services as a result of the above checking...". Examiner is assuming that applicant intended to write .." informing the terminal device to execute the download of an application required for receiving the service when the holder is judged to have right to receive the services as a result of the above checking" because this interpretation is consistent with the inventions disclosure. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,5, 7 and 11 rejected under 35 U.S.C. 102(e) as being anticipated by Ohki.

Claims 1 and 7

- Ohki teaches of checking justifiability of the first portable electronic device based on the data stored in the first portable electronic device.....; reading out application data desired by a holder from the memory when receiving data showing the completion of setting the first portable electronic device ...transmitting the read application data to the terminal device by directing download of the application to the portable electronic device (Col 5, lines 20-30, Col 6, lines 35-45).

Claims 5 and 11

- Ohki teaches of demanding the provision of data including at least individual data stored in the portable electronic device when the provision of service using the portable electronic device is directed by the terminal device; checking whether a user has the right to receive the services based on the data stored in the portable electronic device when the data is received; providing service data desired by a holder when the holder is judged to have the right to receive the services as a result of the above checking; and informing the terminal device to execute the download of an application required for receiving the service when the holder is judged to have right to receive the services as a result of the above checking (Col 5, lines 30-45, Fig 13-14).

4. Claims 13,16, 17-18 and 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Challenger.

Claims 13 and 18

- Challenger teaches about ... checking justifiability of the portable electronic device based on the data store in the portable electronic device when the download direction is received from the terminal device; judging whether the holder has the right to vote from the data stored in the portable electronic device when the portable electronic device is confirmed to be justifiable; reading the application data relative to the vote from the memory when the holder is judged to have the voting right; directing the terminal device to download the application to the portable electronic device and transmitting the read application data relative to the vote; and accepting the accessed data relative to the vote using the portable electronic device with the application relative to the vote downloaded (Col 7, lines 40-65, Col 8, lines 5-12, Fig 7).

Claims 16 and 21

- Challenger teaches of checking justifiability of the portable electronic device based on the data stored in the portable electronic device and checking whether the application relative to the vote is downloaded when the voting directive data by the holder is received; checking justifiability of

the holder based on the code data of the holder when the first portable electronic device is judged as being justifiable and it is confirmed that the application is downloaded in the checking step; accepting the data relative to the vote received by the receiving means when the holder is confirmed to be justifiable by the checking step..(Col 3, lines 60-65, Col 7, lines 50-65, Fig 7).

Claims 17 and 22

- Challenger implicitly teaches of ... directing the invalidation of the application relative to the vote downloaded in the portable electronic....(Fig 7, items 433-441, Fig 8, Col 8, lines 52-67, Col 9, lines 1-25).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-4 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohki and future in view of official notice.

Claims 3-4 and 9-10

- Ohki teaches about checking whether it is possible to download an application data desired by a holder relative to the memory capacity of the set first or second portable electronic device when the data showing the completion of the setting of the first portable electronic device or a second portable electronic device differing from the first portable electronic device is received as a portable electronic device to which the application is downloaded (Col 8, lines Col 20-30). Ohki is silent in regards to demanding the setting of another portable electronic device for downloading an application data when the download is judged being not possible as a result of the above capacity checking; and reading the application data and transmitting the read application when the download is judged to be possible. It is well-known in the art that if downloading or saving a file (data) is not possible because unavailable memory space to request another device to save the file to (ex: saving a file to a floppy disk, computer informs user that there is no available memory and request user to insert a new floppy disk or delete some files on disk), if user chooses to insert a new disk (OS is capable) of recognizing that it is a new disk. It would have been obvious to one of ordinary skill in the art at the time of

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invention to extend Ohki's invention to include this feature because it would result in a more efficient system.

7. Claim 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challenger and future in view of official notice.

Claims 15 and 20

- Challenger teaches about... demanding the setting of a portable electronic device to which the application data relative to the vote is downloaded when the holder is judged to have the voting right(Col 8, lines 1-10); Challenger does not explicitly teach... of judging whether the set portable set electronic device is the first portable electronic device or the second portable electronic device differing from the first portable electronic device when the information showing the setting completion of the portable electronic device to which the application is downloaded....One of ordinary skill in the art at the time of invention would be motivated to make the above-mentioned modifications for the same reasons discussed above in Claim 3.

8. Claims 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challenger.

Claim 14 and 19

- Challenger teaches about executing the step to check justifiability of the portable electronic device based on the data stored in the portable electronic device..(Col 8, lines 1-10). Challenger does not explicitly teach of .. judging whether a date or time data when the download of application is directed is within the pre-set period. It would have been obvious to one of ordinary skill in the art at the time of invention to make the above-mentioned modifications because voting is usually limited to a specific period(date, time). It would have been obvious to modify Challenger's invention so that if the person attempted to vote too early or too late, to not download the ballot and instead supply user with a message indicating that they are not in the correct time frame (date, time). This modification would result in a more efficient and accurate e-voting system. It is for this reason that one of ordinary skill in the art at the time of invention would have been motivated to make the above-mentioned modifications.

9. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohki as applied to claim 1 and 7 above, and further in view of Narasimhan.

Claim 2 and 8

- Ohki does not explicitly teach of ... transmitting the read out application data in the unusable state; and changing the application downloaded in

the portable electronic device from the unusable state to the usable state when the data showing the normal completion of the download is received after transmitting the application data. Narasimhan teaches on this aspect (Col 11, lines 10-35). Adding the above mentioned feature would result in a more secure system because the data can only be decoded by the system interface (i.e. rogue points would be unable to decipher the data). It is for this reason that one of ordinary skill in the art at the time of invention would have been motivated to make the above-mentioned modifications.

10. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohki as applied to claim 1 and 7 above, and further in view of Yoneta.

Claims 6 and 12

- Ohki is silent in regards to ... presenting desired services to the member in the first form to provide service data at the first price indefinitely and the second form to provide service data at prices lower than the first price for a limited period. Yoneta does not explicitly teach of offering the user two choices but does teach of charging the user (Fig 6, Col 7, lines 1-10). It would have been obvious to one of ordinary skill in the art at the time of invention to extend Yoneta's invention to offer the user two options because it would provide a more efficient and user-friendly system. Both

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Ohki and Yoneta's invention relates to extending the useability of IC cards.

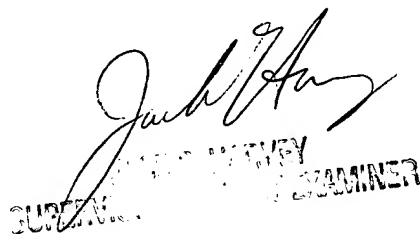
Adding the above-mentioned modification to Ohki's invention would increase the amount of practical applications of the IC card, which is an objective of Ohki's invention (Col 1, lines 35-45). It is for this reason that one of ordinary skill in the art at the time of invention would have been motivated to make the above-mentioned modifications.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl M. Reid whose telephone number is 571 272 3903. The examiner can normally be reached on Mon- Fri (7-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (571)272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmr


JACK HARVEY
SUPERVISOR
EXAMINER

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